

Remarks

Claims 1-20 are pending in this application. The Examiner has required restriction of the claimed invention to one of the following two groups:

- I. claims 1-15 and 20, drawn to a compound and composition;
- II. claims 16-19, drawn to a method of treating a disease.

The Examiner has also required that Applicants elect a species elected within the elected group.

Applicants elect group I, claims 1-15 and 20, with traverse for the reasons set forth below. Applicants further elect the species 3-(4-{[2-(3-benzhydryl-6-chloro-1H-indol-1-yl)ethyl)sulfonyl}phenyl)propanoic acid. This species is encompassed within the scope of claims 1-6, 9 and 13.

Applicants respectfully remind the Examiner that this is not a new application, but a continuation of the prosecution in the same application filed September 29, 2000. Furthermore, a restriction requirement was issued in this application on February 26, 2002, and in response thereto Applicants elected the same species as that elected above. It appears that we are covering ground that was already covered years ago. Since that time, there have been four actions on the merits, which properly would have been issued only after a full and thorough search of the relevant art had been conducted. Applicants have responded to each of these actions and in some cases made amendments to the application in such responses.

The Examiner contends that restriction is necessary because the search of the relevant art would be unduly burdensome. Applicants respectfully point out that such searching has already been performed in this case, and no additional search burden is placed on the Examiner by continuing prosecution, since no new matter to be searched has been (or properly could be) introduced into the application. Therefore, there is no basis for additional restriction at this point in the prosecution.

In view of the extensive searching, examination and prosecution that has already been conducted in the application, it is unfair to Applicants to require further restriction at this late date. It would be a great burden on the Applicants in both time and expense to have to file and prosecute additional applications to cover restricted subject matter after spending more than three years and paying numerous fees prosecuting this application up to this point.

Such additional application(s) would take additional time to issue patents, further shortening the patent term that Applicants will have, since the term is counted starting from the effective filing date and not from the date that a divisional application would be filed. This would deny Applicants the term to which they are properly entitled for the withdrawn subject matter. Had the restriction occurred two years ago, Applicants could have filed divisional application(s) then, but now that time is gone; Applicants should not be penalized with respect to patent term because of the Office delayed issuing a restriction requirement for so long, particularly where all the necessary searches have already been completed.

Furthermore, it would be a burden on the public to have to consider more than one patent, if additional patent applications are required to cover the entire subject matter of claims 1-20. It would also be a burden on the Office to have to handle additional applications. Both the Applicants' and the Office's resources may be put to much better use.

In contrast, it is not a burden on anyone to have all of claims 1-20 appear in the same patent.

For all these reasons, Applicants respectfully request withdrawal of the requirement to restrict the claims to one of groups I and II set forth above.


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